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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,311	12/17/2001	Jeffrey D. Sheely	56695US002	6642
32692	7590	03/31/2004		
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			EXAMINER RUDDOCK, ULA CORINNA	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/024,311

Applicant(s)

SHEELY, JEFFREY D.

Examiner

Ula C Ruddock

Art Unit

1771

eb

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/8/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The Examiner has carefully considered Applicant's response filed January 14, 2004.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102/103

3. Claims 1 and 6-12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Serra et al. (US 5,407,726). Serra et al. disclose adhesive tapes comprising polymeric backing layer and a pressure sensitive adhesive layer (abstract). A reinforcing scrim may be used in the adhesive tape. The backing layer comprises polyethylene (col 2, ln 26-32), which is the same type of backing layer used by Applicant (page 3, line 19 of the present specification). A nonwoven scrim may be incorporated into the tape to enhance tearability and strength and can comprise either polyester or cotton (col 3, ln 19-47). A portion of the adhesive layer will be present in the interstices of the scrim (col 3, ln 27-29).

Serra et al. disclose the claimed invention except for the teaching that the index of refraction of the material of the fibers is within plus or minus 0.2 of the index of refraction of the adhesive and the percentage of light reflected from the tape as diffuse light was at least 15% before the tape was adhered to a substrate and was reduced by at least 10% or 60% by adhering the tape to the substrate.

Although Serra et al. do not explicitly teach the claimed index refraction of the fibers and adhesive or the percentage of reflected light before and after adhering the tape to a substrate, it is reasonable to presume that these properties is inherent to the Serra et al. invention. Support for

said presumption is found in the use of like materials (i.e. polyester or cotton nonwoven scrims, polyethylene backing layers, and adhesive layers). The burden is upon Applicant to provide otherwise. *In re Fitzgerald*, 205 USPQ 594. In addition, the presently claimed property of the index of refraction of the material of the fibers being within plus or minus 0.2 of the index of refraction of the adhesive and the percentage of light being reflected from the tape as diffuse light was at least 15% before the tape was adhered to a substrate and was reduced by at least 10% or 60% by adhering the tape to the substrate would obviously have been present once the Serra et al. product is provided. Note *In re Best*, 195 USPQ at 433, footnote 4 (CCPA 1977) as to the providing of this rejection made above under 35 USC 102.

Rejection is maintained.

Claim Rejections - 35 USC § 103

4. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Serra et al. (US 5,407,726), as shown above, in view of Perez et al. (US 6,331,343). Serra et al. disclose the claimed invention except for the teaching that the scrim is formed of bundles.

Perez et al. disclose fibrous films used in tape backings (col 1, ln 11-12). The fibrous films are made of fiber or fiber bundles (col 15, ln 22 and col 17, ln 19). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used Perez's fiber bundles as the fibers of the scrim of Serra et al. motivated by the desire to create a tape that has a high modulus and tensile strength.

With regard to claims 3 and 5, Serra et al. disclose that the fibers have a denier of approximately 200 denier (col 4, ln 16) and that the tape has finger tearability (col 3, ln 26).

Rejection is maintained.

Response to Arguments

5. Applicant's arguments filed January 14, 2004, have been fully considered but they are not persuasive for the reasons set forth. Applicant argues that Serra et al. do not teach or suggest that both, or either one of their backing layer and their layer of adhesive should be visually transparent. While Serra et al. does fail to explicitly teach that the backing and adhesive layer is visually transparent, because the same materials are being used, both layers will be visually transparent. The specification of the present invention, on page 10, lines 4-5, lists two patents that disclose the typical visually transparent pressure sensitive adhesive used in the present invention. It should be noted that Hamer et al. (US 5,804,610) discloses adhesives made of acrylic at column 6, lines 26-30), which is the same adhesive used in the Serra et al. invention (col 2, ln 41-44). Therefore, the very same adhesive that Applicant discloses as being visually transparent is disclosed by the Serra et al. invention. Applicant also argues that Serra et al. provide no teaching to provide a tape in which only portions of a reinforcing scrim are wetting by an adhesive covering the reinforcing scrim. This argument is not persuasive because if the adhesive is present at the interstices of the scrim only then a portion of the scrim is being wetted by the adhesive. Applicant also argues some of the adhesive suggested by Serra et al. may have indexes of refraction that are not similar to such fibers. This argument is not persuasive because Applicant's claims fail to limit the claims to the use of a specific adhesive. Furthermore, as shown above, Serra et al. discloses the same acrylic adhesive disclosed by the present specification.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ula C Ruddock whose telephone number is 571-272-1481. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

UCR *UCC*

Ula C. Ruddock
Ula C. Ruddock
Primary Examiner
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